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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,486	08/07/2003	Tomoyuki Ohzeki	FSF-031421	1098

37398 7590 02/05/2008  
TAIYO CORPORATION  
401 HOLLAND LANE  
#407  
ALEXANDRIA, VA 22314

EXAMINER

CHEA, THORL

ART UNIT	PAPER NUMBER
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1795

MAIL DATE	DELIVERY MODE
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02/05/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/635,486	<b>Applicant(s)</b> OHZEKI, TOMOYUKI	
	<b>Examiner</b> Thorl Chea	<b>Art Unit</b> 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,5,6,8-11,13-17 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 2,5,6,8-11,13-17 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

### **SUPPLEMENTAL ACTION**

1. This supplemental office action is responsive to the phone call by the Applicants' Counsel on January 30, 2008 with respect to claims 5-6. This office action is substantially similar to that provided on December 11, 2007, except claims 5-6 are included in paragraph 5 shown below wherein the polyvinyl butyral and methyl ethyl ketone organic solvent have been known in Goto et al.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 21, 2, 10-11, 13-17, 19-21 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yoshioka et al (US 2003/0235794A1). See the bisphenols reducing agent of formula ® on page 20, the non-

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photosensitive organic silver salt having silver behenate in the range of 40 mole % to 99 mole % wherein the particle size wherein the value obtained by dividing the standard deviation of the length of the short axis and the long axis respectively by the length of the short axis and long axis is preferably 100 % or less and more preferably 50 % or less, wherein the ratio of the long axis to short axis of 5 or less on page 19, [0121] to [0123] and page 20[0125] to [0128]; silver halide having iodide content of 80 mole % to 100 mole %; the amount thereof in the range of 1 mole % to 7 mole % on page 27, [0176] and [0182], and the size thereof in the range of 10 nm to 45 nm on page 27, [0180]. In column 30, [0225], it is disclosed that "in an alternative method, a prepared photosensitive silver halide is admixed to an organic silver salt at any point during the preparation of organic silver salt. Any of the above methods may be preferably afford the effect of the present invention. The polyvinyl butyral binder and the methyl ethyl ketone solvent are shown on page 31, [0234] and

Yoshioka et al discloses a material with similar composition and the process of forming a silver salt of an organic in presence of silver halide grains as claimed. Therefore, the invention as claimed lacks novelty. Alternatively, it would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use an alternative process of mixing silver halide with silver salt of an organic acid disclosed on page 30, [0225] with an expectation of achieving an equivalent similar results.

5. Claims 5-6, and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshioka et al (US 2003/0235794A1) as applied to claims 21, 2-6, 19-20 above, and further in view of either Goto et al (US Patent No. 6,787,298) or Farid et al (.US Patent No. 5,747,235).. See compound of Goto et al in columns 2-4, and Farid in the abstract and columns 16-18. The

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compound having property as claimed and useful as sensitizer for silver halide emulsion. Goto et al disclose the use polyvinyl butyral in combination with the use of methyl ethyl ketone as solvent on page 81, lines 54-65. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the sensitizer taught in Goto et al or Farid et al in the material of Yoshioka et al for same reason disclosed in Goto et al and Farid, and thereby provide a material as claimed. Moreover, polyvinyl butyral and methyl ethyl ketone have been taught in Goto et al such as shown above.

### ***Response to Arguments***

6. Applicant's arguments filed have been fully considered but they are not persuasive for the reason set forth in the rejection above.

It is the Examiner's position that the "Statement of common ownership" may overcome the prima facie of obviousness rejection, but fails to obviate the rejection under 35 USC 102(e). Yoshioka et al discloses the material having composition as claimed including an alternative method, a prepared photosensitive silver halide is admixed to an organic silver salt at any point during the preparation of organic silver salt within the mixing process claimed in the present claimed invention. Therefore, the silver salt of an organic acid taught in Yoshioka et al has same microstructure as that presented in the Declaration submitted on February 17, 2007.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tch  
2008-01-31

/Thorl Chea/  
Primary Examiner  
Art Unit 1795